



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,934	03/30/2001	David W. Cannell	05725.0878-00	4153

22852 7590 04/18/2005

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER  
LLP  
901 NEW YORK AVENUE, NW  
WASHINGTON, DC 20001-4413

EXAMINER

CHANNAVAJALA, LAKSHMI SARADA

ART UNIT PAPER NUMBER

1615

DATE MAILED: 04/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/820,934

Applicant(s)

CANNELL ET AL.

Examiner

Lakshmi S. Channavajjala

Art Unit

1615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-186 is/are pending in the application.
- 4a) Of the above claim(s) 10-12, 20-28 and 60-186 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 13-19 and 29-59 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

Receipt of amendment and remarks dated 12-16-04 is acknowledged.

Claims 1-186 are pending. Claims 10-12, 20-28, 60-186 have been withdrawn as being non-elected. Claims 1-6, 8, 10-13, 30-32 and 34-54 have been considered for prosecution.

The following rejection of record has been maintained:

1. Claims 1-9, 13-19 and 29-59 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7, 10-17, 27-65, 75-105, 108-115, 125-145 of U.S. Patent No. 6,486,105.
2. Claims 1-9, 13-19 and 29-59 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-85, 152 and 153 of copending Application No. 09/821,480.
3. Claims 1-9, 13-19 and 29-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,495,498 to Niemiec et al (hereafter Niemiec) and US 5688930 to Bertho et al (hereafter Bertho).

Neimeic teaches detergent and conditioning compositions containing a silicone agent, a conditioning agent, surfactants and detergent, for treating hair, skin or nails, particularly as shampoos. The cationic compounds of Neimeic include cationic cellulose

Art Unit: 1615

derivatives such as Polymer JR-400 and Polyquaternium-10 (col. 6, lines 2-13), also described in the instant specification as a suitable film-forming agent. Neimeic further teaches adding surfactants, suspending agents; film-forming agents and other hair care actives in the composition. Among the film-forming agents, Neimeic teaches instant claimed polymers such as Polyquaternium-10 as suitable for forming a continuous coat on the hair (col. 13, lines 1-9). Thus, Neimeic teaches Polyquaternium-10 as essential in the composition for conditioning and film-forming effect. Neimeic teaches incorporating surfactants in the composition for cleansing but fails to teach the claimed monosaccharides.

Bertho, discussed above, teaches the claimed alkyl pentosides as surfactants for hair care compositions. Accordingly, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to add alkyl pentoside mixture of Bertho in the hair composition containing the Polyquaternium-10 hair conditioner (and film-forming agent) of Neimeic because Bertho suggests that their raw material is cheap having economic advantage (col. 1, lines 35-45) and has the ability to act as a surfactant, enhance foaming, emulsifying and detergent power (col. 6, lines 33-35), which is also desired Neimeic because Neimeic is directed to a hair shampoo and conditioning composition containing detergent surfactants as well as conditioners. One of an ordinary skill in the art would have expected to improve the emulsifying power of the composition of Neimeic with a cheaper material of Bertho.

***Response to Arguments***

Applicant's arguments filed 12-16-04 have been fully considered but they are not persuasive.

**Double patenting rejection:** Applicants traverse the double patenting rejection over the co-pending application 09/821,480 and U.S. Patent No. 6,486,105. It is stated that the rejection be held in abeyance until allowable subject matter is indicated. At this time no claims are indicated allowable and for the reasons mentioned in the previous action (and also in the preceding paragraphs), the rejection has been maintained.

**Rejection over Neimeic in view of Bertho:**

Applicants argue that examiner has not provided any motivation or suggestion or teaching of the desirability of making the specific combination of the instant claims i.e., a compound comprising at least two quaternary ammonium groups and at least one sugar chosen from C3 to C5 monosaccharides substituted with at least one C1 to C22 carbon chain. Applicants argue that Niemieic teaches cleansing compositions comprising a water-soluble silicone, a cationic conditioning agent and at least one detergent. Applicants admit that the reference teaches Polyquaternium-10, the elected quaternary ammonium compound. However, they argue that it is only one among many cationic conditioning agents and is not essential. Applicants' argument is not persuasive because while Polyquaternium-10 is described as one of many cationic conditioning agents, Neimeic also specifically teaches the compound as one of the few (not a laundry list) film forming agents for hair applications (col. 13). In response to applicant's

Art Unit: 1615

argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Thus Neimeic clearly teaches polyquarternium-10 as a conditioning agent and as a film-forming agent. Neimeic also teaches combination of surfactants and conditioning (film forming agents) (as also admitted by applicants).

The motivation to add the alkyl pentoside (particularly, XYLIANCE) to the composition of Neimeic as a surfactant comes from the teaching of Bertho. Applicants argue that Neimeic fails to teach the desirability of alkyl glucoside, as the surfactant and that substantial picking and choosing from among the numerous optional ingredients would be required in order to arrive at the instant invention. Bertho states that alkyl pentosides are suitable as anionic surfactants for hair applications and can be used with other surfactants, and exemplifies shampoo compositions (col. 19) having conditioning agents. The advantage of combining the alkyl polyglycosides comes from the teaching of Bertho that these compounds are cheap, act as a surfactant with enhanced foaming, emulsifying and detergent power.

No claim is allowed.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S. Channavajjala whose telephone number is 571-272-0591. The examiner can normally be reached on 9.00 AM -6.30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1615

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Lakshmi S Channavajjala  
Examiner  
Art Unit 1615

April 12, 2005

  
THURMAN K. PAGE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600